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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,473	08/30/2004	Michael J. Berardi	03292.101090.4	9805
66569 7590 10/15/2009 FITZPATRICK CELLA (AMEX) 1290 Avenue of the Americas NEW YORK, NY 10104-3800				
EXAMINER				
KAMAL, SHAHID				
ART UNIT		PAPER NUMBER		
3621				
MAIL DATE		DELIVERY MODE		
10/15/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/810,473

Applicant(s)

BERARDI ET AL.

Examiner

SHAHID KAMAL

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application AFTER FINAL rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the FINALITY of the previous Office action has been WITHDRAWN pursuant to 37 CFR 1.114. Applicant's submission filed on 10 April 2009 has been entered.

Acknowledgements

2. Claims 1-15 are now pending in this application and have been examined.
3. The following is a NON-FINAL Office Action in response to the communication received on 10 April 2009.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3621

5. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (US Patent No.: 7,096,204 B1) ("Chen") in view of Franklin (US Patent No.: 5,883,810) ("Franklin").

6. Referring to claim 1, Chen discloses the following:

a) a transaction device ("secure token/smart card 1220") associated with an account identifier (i.e. true consumer identity/c1,l42-58), said account identifier (i.e. true consumer identity/c1,l42-58) including at least a first account identifier portion (i.e. true consumer identity/c1,l42-58) and a second account identifier portion (i.e. true consumer identity/c1,l42-58), said transaction device ("secure token/smart card 1220") further including a transaction device ("secure token/smart card 1220"), said proxy account identifier (i.e. temporary identity/c15,l1-22) including said first account identifier portion, a first proxy account identifier (i.e. temporary identity/c15,l1-22) storage area and a second proxy account identifier (i.e. temporary identity/c15,l1-22) storage area, said second proxy account (i.e. temporary identity/c15,l1-22) identifier storage area configured to store at least said first account identifier portion (i.e. true consumer identity/c1,l42-58), and said transaction device operable to provide said proxy account identifier (i.e. temporary identity/c15,l1-22) including said first account identifier portion (i.e. true consumer identity/c1,l42-58) to an account identifier (i.e. true consumer identity/c1,l42-58) provider system (see abstract, column 1, lines 42-58 –a secure token containing a true consumer identity and the consumer requesting the purchase from the vendor and providing the temporary identity to the vendor, the vendor requesting transaction authorization from the broker by forwarding the request and the temporary identity to the broker,

Art Unit: 3621

the broker matching the temporary identity to a current list of temporary identities and obtaining the true consumer identity); and

b) an account identifier (i.e. true consumer identity/c1,142-58) provider system in communication with said transaction device for receiving said proxy account identifier (i.e. temporary identity/c15,11-22) including said first account identifier portion (i.e. true consumer identity/c1,142-58), said account provider system operable to associate said first account identifier portion (i.e. true consumer identity/c1,142-58) to said account identifier, said account identifier being associated with a transaction account, and said account identifier provider system operable to receive said first account identifier portion (i.e. true consumer identity/c1,142-58) and provide the corresponding account identifier, to an account identifier provider server for transaction completion (see column 1, lines 42-58 –a secure token containing a true consumer identity and the consumer requesting the purchase from the vendor and providing the temporary identity to the vendor, the vendor requesting transaction authorization from the broker by forwarding the request and the temporary identity to the broker, the broker matching the temporary identity to a current list of temporary identities and obtaining the true consumer identity and the broker providing authorization for the transaction based on transaction details and true consumer identity).

Chen does not expressly disclose database including a proxy account identifier storage area, said transaction device database proxy account identifier storage area operable for storing a proxy account identifier, said proxy account identifier storage area including.

Franklin discloses database including a proxy account identifier storage area, said transaction device database proxy account identifier storage area operable for storing a proxy account

Art Unit: 3621

identifier, said proxy account identifier storage area including (see column 8, lines 57-67, column 9, lines 1-4 –the bank computer identify the account information which is store in the database).

Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified of Chen to include the step(s) taught by Franklin as discussed above in order to provide a method/system for easy retrieval of the “true consumer identity” by using the proxy identifier as an index (see Franklin: column 9, lines 37-40).

7. Referring to claim 2, Chen further discloses wherein said account identifier (i.e. true consumer identity) provider system is operable to provide said account identifier to said account identifier provider server (i.e. secure token) in accordance with said first account identifier portion (see column 1, lines 47-49 –the consumer obtaining a temporary identity from the broker by using the true consumer identity from the secure token).

8. Referring to claim 3, Chen further discloses wherein said account identifier provider system is operable to generate said second account identifier portion in accordance with a predetermined algorithm operated on said account identifier first portion, said account identifier provider system is operable to provide said account identifier to said account identifier provider server in accordance with said first account identifier portion and said generated account identifier second portion (see column 1, lines 42-58 –a secure token containing a true consumer identity and the consumer requesting the purchase from the vendor and providing the temporary identity to the vendor).

9. Referring to claim 4, Chen does not expressly disclose wherein said account identifier provider system further includes an account identifier provider database, said account identifier provider database operable to store said account identifier, wherein said account identifier provider system is operable to locate said stored account identifier in accordance with a predetermined algorithm operated on said first account identifier portion.

Franklin discloses wherein said account identifier provider system further includes an account identifier provider database, said account identifier provider database operable to store said account identifier, wherein said account identifier provider system is operable to locate said stored account identifier in accordance with a predetermined algorithm operated on said first account identifier portion (see column 8, lines 57-67, column 9, lines 1-4 –the bank computer identify the account information which is store in the database).

Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified of Chen to include the step(s) taught by Franklin as discussed above in order to provide a method/system for easy retrieval of the “true consumer identity” by using the proxy identifier as an index (see Franklin: column 9, lines 37-40).

10. Referring to claim 5, Chen does not expressly disclose wherein said account identifier provider system further includes an account identifier provider database, said account identifier provider database operable to store said second account identifier portion, wherein said account identifier provider system is operable to locate said stored second account identifier portion in accordance with a predetermined algorithm operated on said first account identifier portion, said

Art Unit: 3621

account identifier provider system is operable to provide said account identifier to said account identifier provider server in accordance with said first account identifier portion and said located second account identifier portion.

Franklin discloses wherein said account identifier provider system further includes an account identifier provider database, said account identifier provider database operable to store said account identifier second portion, wherein said account identifier provider system is operable to locate said stored account identifier second portion in accordance with a predetermined algorithm operated on said account identifier first portion, said account identifier provider system is operable to provide said account identifier to said account identifier provider server in accordance with said account identifier first portion and said located account identifier second portion (see column 8, lines 57-67, column 9, lines 1-4 –the bank computer identify the account information which is store in the database).

Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified of Chen to include the step(s) taught by Franklin as discussed above in order to provide a method/system for easy retrieval of the “true consumer identity” by using the proxy identifier as an index (see Franklin: column 9, lines 37-40).

11. Referring to claim 6, Chen further discloses a merchant system in communication with said transaction device system, said transaction device system operable to provide said proxy account identifier to said merchant system, said merchant system in further communication with said account identifier provider system, said merchant system operable to provide said

Art Unit: 3621

proxy account identifier including said first account identifier portion to said account provider system (see column 1, lines 47-50 –consumer get an account identity from a vendor).

12. Referring to claim 7, Chen further discloses wherein said transaction device (i.e. secure token) system is operable to provide said proxy account identifier in a merchant system recognizable format (see column 1, lines 47-55 -secure token identified with temporary identity).

13. Referring to claim 8, Chen further discloses a transaction device reader in communication with said transaction device system, said transaction device reader in further communication with said merchant system, said transaction device reader operable to receive said proxy account identifier and to provide said proxy account identifier to said merchant system (see column 1, lines 42-58 -secure token containing true consumer identity and further create a temporary identity for the vendor system).

14. Referring to claim 9, Chen further discloses wherein said proxy account identifier is in International Standards Organization (ISO) compatible magnetic stripe format (see column 12 lines 6-14 –ISO/IEC).

15. Referring to claim 10, Chen further discloses wherein said proxy account identifier includes said first account identifier portion in at least one track of an ISO compatible magnetic stripe format (see column 12 lines 6-14 –ISO/IEC).

16. Referring to claim 11, Chen further discloses wherein said transaction device is operable to provide said proxy account identifier including said first account identifier portion to an account identifier provider system in a contactless transmission medium (see column 1, lines 42-58 –a secure token containing a true consumer identity and the consumer requesting the purchase from the vendor and providing the temporary identity to the vendor, the vendor requesting transaction authorization from the broker by forwarding the request and the temporary identity to the broker, the broker matching the temporary identity to a current list of temporary identities and obtaining the true consumer identity and the broker providing authorization for the transaction based on transaction details and true consumer identity).

17. Referring to claim 12, Chen further discloses wherein said contactless transmission medium is radio frequency (see column 1, lines 45-46 –the medium is a secure token).

18. Referring to claim 13, Chen discloses the following: receiving a proxy transaction device account identifier, wherein the proxy transaction device identifier includes at least one portion of a transaction device identifier associated with a transaction account; providing a transaction account identifier in accordance with a portion of the proxy transaction device identifier, the portion of the proxy transaction device identifier corresponding to a portion of the transaction account identifier; and correlating the transaction account identifier with a transaction account for use in satisfying a transaction (see column 1, lines 42-58 –a secure token containing a true consumer identity and the consumer requesting the purchase from the vendor and providing the temporary identity to the vendor, the vendor requesting transaction authorization from the broker

Art Unit: 3621

by forwarding the request and the temporary identity to the broker, the broker matching the temporary identity to a current list of temporary identities and obtaining the true consumer identity and the broker providing authorization for the transaction based on transaction details and true consumer identity).

19. Referring to claim 14, Chen further discloses receiving the proxy transaction device identifier in International Standards Organization magnetic stripe format, wherein the proxy transaction device identifier includes at least a first proxy identifier portion and a second proxy identifier portion, wherein at least the first proxy identifier portion includes a portion of transaction account identifier (see column 12 lines 6-14 –ISO/IEC).

20. Referring to claim 15, Chen discloses the following: providing a transaction device associated with a proxy account identifier, the proxy account identifier having at least a first proxy account identifier portion; associating the first proxy account identifier portion with a transaction account identifier; the transaction device identifier including first and second transaction account identifier portions; storing the first transaction account identifier portion in the first proxy account identifier portion; and providing the first transaction account identifier portion to a transaction account provider for use in determining the transaction account identifier for use in completing a transaction (see column 1, lines 42-58 –a secure token containing a true consumer identity and the consumer requesting the purchase from the vendor and providing the temporary identity to the vendor, the vendor requesting transaction authorization from the broker by forwarding the request and the temporary identity to the broker, the broker matching the

Art Unit: 3621

temporary identity to a current list of temporary identities and obtaining the true consumer identity and the broker providing authorization for the transaction based on transaction details and true consumer identity).

Chen does not expressly disclose a database for storing the proxy account identifier.

Franklin discloses providing a database for storing the proxy account identifier (see column 8, lines 57-67, column 9, lines 1-4 –the bank computer identify the account information which is store in the database).

Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified of Chen to include the step(s) taught by Franklin as discussed above in order to provide a method/system for easy retrieval of the “true consumer identity” by using the proxy identifier as an index (see Franklin: column 9, lines 37-40).

Response to Arguments

21. Applicant's arguments filed on March 10, 2008 have been fully considered but they are not persuasive.
22. As per claims 1-15, Applicant argues “Chen does not disclose a transaction device associated with an account identifier, said account identifier including at least a first account identifier portion and a second account identifier portion, said transaction device further including a transaction device, said proxy account identifier including said first account identifier portion, a first proxy account identifier storage area and a second proxy account identifier storage area, said second proxy account identifier storage area configured to store at least said first account identifier portion, and said transaction device operable to provide said

Art Unit: 3621

proxy account identifier including said first account identifier portion to an account identifier provider system; and an account identifier provider system in communication with said transaction device for receiving said proxy account identifier including said first account identifier portion, said account provider system operable to associate said first account identifier portion to said account identifier, said account identifier being associated with a transaction account, and said account identifier provider system operable to receive said first account identifier portion and provide the corresponding account identifier, to an account identifier provider server for transaction completion (response pages 2-4)” and “Franklin does not disclose database including a proxy account identifier storage area, said transaction device database proxy account identifier storage area operable for storing a proxy account identifier, said proxy account identifier storage area including (response pages 2-4)”.

23. Chen disclose a transaction device associated with an account identifier, said account identifier including at least a first account identifier portion and a second account identifier portion, said transaction device further including a transaction device, said proxy account identifier including said first account identifier portion, a first proxy account identifier storage area and a second proxy account identifier storage area, said second proxy account identifier storage area configured to store at least said first account identifier portion, and said transaction device operable to provide said proxy account identifier including said first account identifier portion to an account identifier provider system (see abstract, column 1, lines 42-58 –a secure token containing a true consumer identity and the consumer requesting the purchase from the vendor and providing the temporary identity to the vendor, the vendor requesting transaction authorization from the broker by forwarding the request and the temporary identity to the broker,

Art Unit: 3621

the broker matching the temporary identity to a current list of temporary identities and obtaining the true consumer identity); and an account identifier provider system in communication with said transaction device for receiving said proxy account identifier including said first account identifier portion, said account provider system operable to associate said first account identifier portion to said account identifier, said account identifier being associated with a transaction account, and said account identifier provider system operable to receive said first account identifier portion and provide the corresponding account identifier, to an account identifier provider server for transaction completion (see column 1, lines 42-58 –a secure token containing a true consumer identity and the consumer requesting the purchase from the vendor and providing the temporary identity to the vendor, the vendor requesting transaction authorization from the broker by forwarding the request and the temporary identity to the broker, the broker matching the temporary identity to a current list of temporary identities and obtaining the true consumer identity and the broker providing authorization for the transaction based on transaction details and true consumer identity), and Franklin discloses database including a proxy account identifier storage area, said transaction device database proxy account identifier storage area operable for storing a proxy account identifier, said proxy account identifier storage area including (see column 8, lines 57-67, column 9, lines 1-4 –the bank computer identify the account information which is store in the database).

Conclusion

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 3621

25. Any inquiry concerning this communication or earlier communications from the patent examiner should be directed to Shahid Kamal whose telephone number is (571) 270-3272. The Patent examiner can normally be reached on Monday-Thursday (8:30am -7:00pm), Friday off.

26. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Fischer can be reached on (571) 272-6779. The fax phone number for this origination where this application or proceeding is assigned is (571) 273-8300.

27. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published application may be obtained from either Private PAIR or Public PAIR.

28. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-directed.uspto.gov>.

29. Should you have any questions on accessing to the Private PAIR system, contact the Electronic Business Center (EBC) at 1(866) 217-9197 (toll free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 1(800) 786-9199 (IN USA OR CANADA) or 1(571) 272-1000.

SK
October 10, 2009

/EVENS J. AUGUSTIN/

Primary Examiner, Art Unit 3621